

Non-use Cancellation of Trademarks may no Longer be Possible in Turkey

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Constitutional Court in Turkey has ruled that Article 42/1 (c), which provides for the non-use of a trademark as one of the grounds of invalidity, is unconstitutional because it violated Article 91/1 of the Turkish Constitution.

Article 91/1 of the Turkish Constitution regulates that basic rights, including right of ownership, cannot be regulated / limited by Decree Laws. Turkish Trademark Law, Decree Law no 556, is a Decree Law which was passed by cabinet not by parliament.

Turkish Trademark Law has not separated grounds for invalidity and grounds for cancellation, which all has listed in Article 42 of Turkish Trademark Law under the name of invalidity.

In its ruling, Constitutional Court stated, briefly, that trademarks which have not meet use requirements gives its holder trademark rights at least to the expiration of grace period for non-use. Article 42 of Turkish Trademark Law, however, regulates non-use as a ground for invalidation which requires removal of all rights given by that registration, including trademark rights existed before the expiration of grace period for non-use. Since invalidation of a trademark registration based on non-use results with removal of trademark rights which existed in the period where use was not a requirements, it is denial of an existing right of ownership. So such regulation by Decree Law violates Article 91/1 of the Turkish Constitution.

The full text of Article 42 of Turkish Trademark Law is as under;

Invalidity

Article 42 - A registered trademark shall be declared invalid by the court in following cases:

- a) where in breach of Article 7, (However, the action regarding well-known trademarks as specified subparagraph (i) of Article 7 has to be instituted within five years **from the date of registration**. If there is bad faith time limit shall not apply.)
- b) where in breach of Article 8, (However, regarding the proceedings instituted under the last paragraph of Article 8, if the previous right holder has not used his trademark within the two years after the expiry of the period of protection it will not constitute a reason for invalidity.)
- c) where in breach of Article 14, (However, serious use between the date of instituting of the proceedings and the expiry of the years shall not constitute a reason of invalidity. If use has been made upon realisation that proceedings are to be instituted, in such a case the court shall not take into consideration the use within three months prior of the institution of the proceedings.)
- d) where the trademark has become generic in respect of the goods or services by the acts of the proprietor of the trademark,
- e) where, as result of the use made by the proprietor or by the person authorised by him, there exists a likelihood of confusion on the part of the public as to the nature, quality, place of production and geographical origin in respect of the goods or services it is registered,
- f) where used in breach of Article 59,

Where the invalidity is involved only for some of the products or services, partial invalidity shall be ruled with respect of those products and services.

Where the trademark having been used before the registration has acquired through this usage distinctive character in respect of the goods and services for which it is to be registered, the provisions of (b), (c) & (d) cannot be invoked to invalidate the registration.

The provision cancelled by Constitutional Court is Article 42/1 (c) which is underlined above. Article 14 of Turkish Trademark Law, which is referred by 42/1-c, is as under;

Use of the Trademark

Article 14 - *If, within a period of five years following the registration, trademark has not been put to use without a justifiable reason or if the use has been suspended during an uninterrupted period of five years, the trademark shall be cancelled.*

The following shall be understood to constitute use:

- a) use of the registered mark in a form differing in elements which do not alter the distinctive character of the trademark,*
- b) use of the trademark on goods or their packaging solely for export purposes,*
- c) use of the trademark with the consent of the proprietor,*
- d) importing of the goods carrying the trademark.*

Although Article 14 still exists, the link with Article 42 is not there anymore. So whether non-use cancellation is still possible is a matter of interpretation of Appeal Court.

At the moment, from a legal standpoint there is considerable interpretative uncertainty concerning the situation of non-used trademarks since the article 14 of Decree Law has become impracticable although it is still in force. It is now awaited to see how the cancellation of article 42/1-c of Decree Law would be applied by the IP courts and Appeal Court in respect of the pending or newly instituted actions based on non-use.

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